UNITED STATES PATENT AND TRADEMARK OFFICE

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10/696,956	10/30/2003	Casey Vandeputte	555255012537	8491

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ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _30 October 2003_.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-15_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-15_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on _30 October 2003_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

    1. ☐ Certified copies of the priority documents have been received.

    2. ☐ Certified copies of the priority documents have been received in Application No. _____.

    3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _08/19/2004_.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   This Office Action is responsive to the communication filed on 10/30/2003.

2.   Claims 1-15 have been presented for examination.

Drawings

3.   The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they

include the following reference character(s) not mentioned in the description: [FIG 5] 424A,

424B. 424C. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to

the specification to add the reference character(s) in the description in compliance with 37 CFR

1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any

amended replacement drawing sheet should include all of the figures appearing on the immediate

prior version of the sheet, even if only one figure is being amended. Each drawing sheet

submitted after the filing date of an application must be labeled in the top margin as either

"Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not

accepted by the examiner, the applicant will be notified and informed of any required corrective

action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
> in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
> patent by another filed in the United States before the invention by the applicant for patent, except that an

international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   Claims 1,5, and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by

Zondervan (USPN 7030730).

6.   As per claim 1, Zondervan teaches a method for formatting an electronic message sent

from a mobile communication device and addressed to a first electronic mail account, the mobile

communication device being associated with a second electronic mail account in an electronic

messaging system, comprising:

receiving the electronic message – receive messages ([COL 5 lines 34-36]) from the

mobile communication device - 26 at the electronic messaging system –FIG 1;

identifying a message format –processing informational message ([COL 5 lines 33-36])

associated with the second electronic mail account – desktop mail application ([COL 4 lines 62-

65] e.g., Lotus Notes);

formatting the electronic message using the identified message format – formatting in

accordance with Lotus Notes ([COL 5 lines 34-36]); and

sending the formatted electronic message using the identified message format to the first

electronic mail account – 16 ([FIG 1], [ABSTRACT lines 20-21])

wherein electronic messages sent from either the mobile communication device or from

the second electronic mail account include the message format associated with the second

electronic mail account – reply messages from pager match the format of received messages

([COL 3 lines 40-44]).

7.   As per claim 5, Zondervan teaches the method of claim 1, wherein the first electronic

mail account – 16 is in the electronic messaging system – FIG 1.

8.   As per claim 15, Zondervan teaches an electronic messaging system –FIG 1 having a mail server operable to send and receive electronic messages –132 ([FIG 3], [COL 2 lines 65-67]) and having an enterprise server -12 operable to redirect electronic messages to an from a mobile communication device ([COL 5 lines 10-12]) that is associated with an electronic messaging account –desktop e-mail application ([COL 4 line 64]) in the electronic messaging system –FIG 1, the enterprise server comprising:

     a memory subsystem – 24 ([FIG 1]) operable to store data and program information;

     a processing subsystem – 20 operable to store and retrieve data in the memory subsystem and execute programs stored in the memory subsystem; and

     a message formatting program –22 stored in the memory subsystem and executed by the processing subsystem, the message formatting program being operable to cause the enterprise server to identify a message format –Lotus Notes ([COL 5 line 36]) for an electronic message received from the mobile communication device -18, reformat the received electronic message using the identified message format ([COL 5 lines 6-8], and redirect the reformatted message ([COL 5 lines 10-11]) for delivery by the electronic messaging system -12;

     wherein the identified message format is used for both electronic messages sent from the mobile communication device and for electronic messages - – reply messages from pager match the format of received messages ([COL 3 lines 40-44]) sent from a desktop client - 114 associated with the electronic messaging account – desktop mail application ([COL 4 line 64])

Claim Rejections - 35 USC § 103

9.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

10.   The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459

(1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and the claims at issue.
3.   Resolving the level of ordinary skill in the pertinent art.
4.   Considering objective evidence present in the application indicating obviousness
or nonobviousness.

11.   Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zondervan (USPN

7030730) over Hiroki (USPN 2003/0068021))

12.   As per claim 6, Zandervan does not teach the method of claim 1 wherein the first

electronic mail account is in another electronic messaging system. However, Hiroki teaches an

electronic mail account – 107 ([FIG 3]) located in another electronic messaging system – 202

([FIG 2])

Therefore at the time the invention was made one of ordinary skill in the art would have

motivation to implement a portable terminal device (including an e-mail application) located in

another messaging system. Since portable terminals can comprise pagers, PDAs, or mobile

phones, among others, it would have been obvious to have sent a formatted message to another device in another messaging system.

13.   Claims 2-4 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zondervan (USPN 7030730) over Eason (USPN 2005/0039028)

14.   As per claims 2 and 8, Zondervan does not disclose wherein the message format includes a font type. However, Eason teaches applying a font type to a message text ([0028 line 4]).

Therefore at the time the invention was made one of ordinary skill in the art would have motivation to include a font type as a message format. Zondervan teaches the use of Lotus Notes as an e-mail application, and typical e-mail applications provide for selecting a font type. Furthermore, since a user would change the font type of an electronic message for stylistic reasons, and given that the received message taught in Zondervan includes a message body, one of ordinary skill in the art would have motivation to include the font type as part of the message format.

15.   As per claims 3 and 9, Eason teaches wherein the message format includes a font size ([0028 line 6]).

16.   As per claim 4 and 10, Eason teaches wherein the message format includes a font color ([0028 – line 8])

17.   Claims 7 and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zondervan (USPN 7030730) over Thankachan (USPN 2002/0184317).

18.   As per claim 7, Zondervan teaches a method for formatting electronic messages sent from a mobile communication device and addressed to a first electronic mail account, the mobile

communication device being associated with a second electronic mail account in an electronic

messaging system, comprising:

receiving a first electronic message -([ABSTRACT lines 7-9], [COL 4 lines 32-33]) at

the electronic messaging system – FIG 1, the first electronic message including a message format

– fields, message, date ([COL 5 lines 36-40])

redirecting the first electronic message from the electronic messaging system to the

mobile communication device – scripting agent forwards processed message to paging server

([COL 5 lines 5-10]);

receiving a second electronic message –reply message ([COL 5 line 7]) from the mobile

communication device -26 at the electronic message system –FIG 1, the second electronic

message being addressed to the first electronic mail account – desktop mail application ([COL 4

line 64], [COL 5 line 12]) and including a message body – body of text message ([COL 5 line

39]).

identifying a message format of the second text portion –received message ([COL 5 line

9]) e.g., it is provided that received message is based on Lotus Notes. Examiner interprets that

formatting a message in this manner requires an identification of the originating format prior to

any message conversion)

formatting the first text portion –reply message ([COL 5 line 7]) using the message

format of the second text portion –received message ([COL 5 line 9]) ; and

sending the formatted second electronic message to the first electronic mail account –

desktop mail application ([COL 4 line 64].

Zondervan teaches that the message body includes a first text portion originated at the mobile communication device –reply message; however, it does not teach a second text portion copied from the first electronic message that is included in one message body. Thankachan teaches that the original message, i.e., second text portion, of an e-mail is copied and inserted into the reply –first text portion ([0019 lines 5-6]).

Therefore, it would have been obvious to one of ordinary skill in the art to copy the received message into the body of the reply message. Zondervan provides for formatting the reply message using the received message. Thankachan provides for placing a copy of the received message into the reply message. Since the message body of the e-mail may be conglomerated using a copy of the received message body with the reply message, it would have been obvious to have used the message body (comprising the received message) as a source in which of the reply message may identify its target format via using the format of the received message.

19.   As per claim 11, Zondervan teaches the method of claim 7, wherein the first electronic message is sent from the first electronic mail account –desktop mail application ([COL 4 lines 62-67] and the second electronic message is a reply message ([COL 5 lines 7-9]).

20.   As per claim 12, Zondervan teaches the method of claim 7, wherein the first electronic message is sent from a third electronic mail account – integrated messaging system ([COL 7 lines 13-18]) and the second electronic message is a forward message ([COL 5 line 43]).

21.   As per claim 13, Zondervan teaches the method of claim 7 wherein the message format is identified from metadata ([COL 5 lines 36-39]) included in the first electronic message.

22.   As per claim 14, Zondervan teaches the method of claim 13, wherein the message format

is identified from a content type field-description of subject matter ([COL 5 lines 36-39]) in the

first electronic message.

Conclusion

23.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

6529942 – system and method for providing recipient specific formats for e-mail

6629130 – method for processing e-mail

20040266411 – message format conversion in communication terminals

2005/0027781 – method for automatically formatting e-mail

20060031299 – system and method for mimetic messaging

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Darrin Dunn whose telephone number is (571) 270-1645. The

examiner can normally be reached on EST:M-R(8:00-5:00) 9/5/4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Anthony Knight can be reached on (571) 272-3687. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DD
07/05/2006

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